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July 19, 2023

BY ECF

Honorable Brian M. Cogan, United States District Court Judge
United States District Court for the Eastern District of New York
225 Cadman Plaza East
Brooklyn, NY 11201

Re: *SES-imagotag SA, et al. v. Hanshow America Inc., et al.*, 1:23-cv-01667-BMC

Dear Judge Cogan:

Plaintiffs write to respectfully request leave to file a Sur-Reply memorandum of no more than six (6) pages to respond to new legal arguments presented for the first time in Defendants' Reply Memorandum in Support of its Rule 12(b)(6) Motion to Dismiss Due to Patent Ineligibility Under 35 U.S.C. § 101 (Dkt. 39) ("Reply"). Alternatively, Plaintiffs request that the Court not consider these new legal arguments.

Plaintiffs' counsel met and conferred with Defendants' counsel via video conference to discuss the newly raised legal arguments and to get their consent to request leave to file a Sur-Reply. Defendants' counsel did not consent to the request, necessitating this letter application.

In Defendants' Reply, which was granted an extension to twelve (12) pages (Dkt. 38), Defendants presented two new legal arguments that were not made in Defendants' opening motion (Dkt. 36). These new arguments are significant as they relate to the disputed issues underlying the *Alice* two-part test. First, Defendants presented a new legal argument by alleging that step one of *Alice* does not involve a consideration of any factual questions. *See, e.g.*, Dkt. 39 at 1-2. Second, with respect to *Alice* step two, Defendants presented a new legal argument that alleges that Plaintiffs have the burden to identify an "inventive concept" at the motion to dismiss stage and have not done so. *See, e.g., id.* at 12. Plaintiffs should be given a fair opportunity to respond to these new arguments raised for the first time in Defendants' Reply brief.

It is well-established that "[a]rguments may not be made for the first time in a reply brief." *Knipe v. Skinner*, 999 F.2d 708, 711 (2d Cir. 1993); *see also AICO Intern., E.C. v. Merrill Lynch & Co., Inc.*, 98 F. App'x 44, 46 (2d Cir. 2004) ("declin[ing] to consider whether there was jurisdiction under the Convention because it was not raised by AICO until its reply brief on appeal."). In fact, this Court has "offered [] an opportunity to submit a sur-reply [where a party] had raised [an] argument for the first time in their reply brief." *Mitchell v. Lyons Prof'l Servs., Inc.*, No. 09 Civ. 1587 (BMC), 2013 WL 12360723, at *1 n.1 (E.D.N.Y. Oct. 1, 2013) (J.

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Cogan). This Court has also disregarded new arguments made “for the first time” in a defendant’s “reply memorandum.” *Miranda v. South Country Central School Dist.*, 461 F. Supp. 3d 17, 26 (E.D.N.Y. 2020) (J. Cogan).

Accordingly, Plaintiffs respectfully request leave to file a brief Sur-Reply memorandum of no more than six (6) pages addressing the two new legal arguments in Defendants’ Reply. Alternatively, Plaintiffs respectfully request that the Court disregard Defendants’ new arguments when considering the instant motion.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on July 19, 2023, the foregoing document was electronically filed with the Clerk of the Court using the CM/ECF system, which will send a notification of such filing (NEF) to all counsel of record.

Dated: July 19, 2023

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